REMARKS

This document is filed in reply to the Final Office Action dated March 28, 2006 ("Office Action").

Initially, Applicants would like to thank the Examiner for granting the teleconference on June 26, 2006 to discuss claim 1 of this application. Previously presented claim 1 is drawn to an isolated nucleic acid containing a nucleotide sequence at least 70% identical to SEQ ID NO:1, or its complementary sequence. The presence of the nucleic acid in a subject predisposes the subject to an abnormal liver condition, an adenocarcinoma, or both. During the teleconference, Applicants' counsel proposed amending claim 1 to replace "75%" with "95%" and replace "an abnormal liver condition, an adenocarcinoma" with "non-A-E hepatitis, hepatitis B, hepatitis C, or colon cancer," i.e., incorporating into claim 1 the limitations of claims 2 and 5. The Examiner acknowledged the proposed amendments and agreed to reconsider this case.

Applicant has herein amended claim 1 in the manner mentioned above, necessitating cancellation of claims 2-5. Applicant has amended claim 12, drawn to an isolated nucleic acid, to (i) point out that the nucleic acid encodes a polypeptide having the sequence of SEQ ID NO: 2 and (ii) replace "an abnormal liver condition, an adenocarcinoma" with "non-A-E hepatitis, hepatitis B, hepatitis C, or colon cancer." Support for "encodes a polypeptide having the sequence of SEQ ID NO: 2" can be found at page 3, lines 8-16 of the specification. Applicant has also amended claim 14, drawn to a cell, to specify that the cell is a cultured cell. Support for a cultured cell appears at the specification, page 3, lines 9-10.[1] No new matter is introduced.

The amendments should be entered as they raise no new issues that will require further consideration or search and also do not touch the merits of the application within the meaning of 37 C.F.R. § 1.116(b).

---

[1] This passage of the specification recites "a cell (in a culture ...) containing a nucleic acid of the invention." With this teaching, one skilled in the art would clearly recognize that the cell in a culture is "a cultured cell." Note that a claim does not have to be set forth verbatim in the specification. In *In re Wright*, 9 USPQ2d 1649 (Fed. Cir. 1989), the Federal Circuit, in reversing a Board's 35 U.S.C. § 112, first paragraph rejection, held that there was adequate written description support for applicant's claim limitation, despite the fact that it was not set forth "*in haec verba*" (i.e., "in these words" or "verbatim") in the specification.

Upon entry of the proposed amendments, claims 1 and 6-28 will be pending. Among them, claims 7-11, 13, and 15-28 have been withdrawn from further consideration for covering a non-elected invention. Claims 1, 6, 12, and 14 are under examination. Reconsideration of the application is respectfully requested in view of the remarks below.

Rejection under 35 U.S.C. § 112, first paragraph (enablement)

Claims 1-6, 12, and 14 remain rejected under 35 U.S.C. § 112, first paragraph for lack of enablement. See the Office Action, page 2, line 6 to page 4, line 11.

Previously presented claim 1 recites "70% identical to SEQ ID NO:1" and "an abnormal liver condition, an adenocarcinoma." According to the Office Action, "the specification ... does not reasonably provide an isolated nucleic acid comprising a nucleotide sequence having at least 70% identity to SEQ ID NO: 1, wherein the presence of said nucleic acid in a subject predisposes the subject to any abnormal liver condition or adenocarcinoma ..." In other words, it is the Examiner's position that claim 1 is overly broad.

While not conceding the appropriateness of this rejection, Applicant has cancelled claims 2-5 and narrowed the scope of claim 1 by replacing "75%" with "95%" and replacing "an abnormal liver condition, an adenocarcinoma" with "non-A-E hepatitis, hepatitis B, hepatitis C, or colon cancer" in the sole interest of moving this case toward allowance. In view the above amendments, as well as the remarks set forth in the previous response, Applicant submits that amended claim 1 meets the enablement requirement.

Claim 6, dependent from claim 1, covers an isolated nucleic acid having a nucleotide sequence 100% identical to SEQ ID NO:1, or its complementary sequence. For the same reasons set forth above, it also meets the enablement requirement.

The Examiner also rejected claims 12 and 14 on the same ground discussed above. Applicant has narrowed the scope of these two claims and submits that they meet the enablement requirement.

In view of the above amendments and the remarks, withdrawal of the rejection is respectfully requested.

Rejection under 35 U.S.C. § 112, first paragraph (written description)

Claims 1-6 and 14 remain rejected under 35 U.S.C. § 112, first paragraph for lack of written description. See the Office Action, page 4, second paragraph.

As discussed above, Applicant has cancelled claims 2-5 and narrowed the scope of the other claims at issue. In view of the amendments, as well as the remarks set forth in the previous response, Applicant submits that the rejection is overcome or rendered moot.

CONCLUSION

Applicant submits that grounds for the rejections asserted by the Examiner have been overcome, and that claims, as pending, define subject matter that is enabled and sufficiently described. On this basis, it is submitted that allowance of this application is proper, and early favorable action is solicited.

Please apply any other charges to deposit account 06-1050, referencing the Attorney's Docket No. 14176-003001.

Respectfully submitted,

Date: 6-28-2006

Jianming Hao, Ph.D.
Reg. No. 54,694

PTO Customer No. 26161
Fish & Richardson P.C.
Telephone: (617) 542-5070
Facsimile: (617) 542-8906